



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,965	06/28/2000	Mark Kirkpatrick	BS00-055	6374

28970 7590 08/04/2004

SHAW PITTMAN  
IP GROUP  
1650 TYSONS BOULEVARD  
SUITE 1300  
MCLEAN, VA 22102

EXAMINER

OPSASNICK, MICHAEL N

ART UNIT

PAPER NUMBER

2655

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/604,965

Applicant(s)

KIRKPATRICK, MARK

Examiner

Michael N. Opsasnick

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,2,4-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (5479411) in view of Sit et al (6349336) in further view of Cooper et al (6052442) in view of Detlef (6351523).

As per claims 1,7,8,13,14,22,26,28,32,34,39,42, Klein (5479411) teaches an email notification system comprising:

“an email server.....stored” as email network (col. 4 lines 20-25)

“an email notification.....email message” as retrieving email in a convention email system (col. 4 lines 20-25)

“a header extraction process.....email” as extracting header email info (col. 2 lines 40-50)

“a text to speech converter....information.....voicemail message” as converting the header email and delivered a voice mail message (col. 2 lines 20-40);

Art Unit: 2655

“wherein the voicemail server includes a process to notify the subscriber of the voicemail message” as teaching notifying the subscriber of the voicemail message containing the converted header information (col. 6 lines 1-22)

Klein (5479411) does not explicitly teach the details of the polling process, however, Sit et al (6349336) teaches the communication protocols involving email servers, especially with automatic polling (col. 4 lines 45-60). Therefore, it would have been obvious to one of ordinary skill in the art of email communications to automatically periodically poll an email server because it would advantageously allow for updating and monitoring the performance of the server (Sit et al (6349336) col. 4 lines 55-60).

The combination of Klein (5479411) in view of Sit et al (6349336) does not explicitly teach checking for new email messages when a predetermined amount of time as elapsed, however, Cooper et al (6052442) teaches periodic checking for new email at predetermined intervals (Cooper et al (6052442), col. 8 lines 7-12; col. 8 lines 14-37). Therefore, it would have been obvious to one of ordinary skill in the art of retrieving emails to modify the teachings of Klein (5479411) in view of Sit et al (6349336) to automatically retrieve new emails at periodic intervals because it would advantageously allow the user to specify the time of day to retrieve new emails, without having to be there physically (col. 8 lines 18-20).

Art Unit: 2655

The combination of Klein (5479411) in view of Sit et al (6349336) in further view of Cooper et al (6052442) does not explicitly teach the email server calling the voicemail server to leave a message, however, Detlef (6351523) teaches an email to voicemail notification process (col. 4 lines 45-55). Therefore, it would have been obvious to one of ordinary skill in the art of voice/email messaging to modify the teachings of the combination of Klein (5479411) in view of Sit et al (6349336) in further view of Cooper et al (6052442) with a email to voicemail notification process because it would advantageously distinguish special purpose email/voicemail from conventional emails (Detlef (6351523), col. 4 lines 47-49, col. 3 lines 1-10).

As per claims 2,9,13,14,26,35, 40,41, the combination of Klein (5479411) in view of Sit et al (6349336) in further view of Cooper et al (6052442) teaches notifying the subscriber of the voicemail message containing the converted header information (Klein (5479411), col. 6 lines 1-22)

As per claims 3,5,6,11,12,15,17,25,31,36,38,43,44, the combination of Klein (5479411) in view of Sit et al (6349336) in further view of Cooper et al (6052442) teaches control protocols (Klein (5479411), col. 3 lines 46-67)

As per claims 4,10,12,16,23,24,29,30,37,45, the combination of Klein (5479411) in view of Sit et al (6349336) in further view of Cooper et al (6052442) teaches multiple email accounts and servers (Klein (5479411), col. 4 lines 20-31; furthermore, the combination of the Klein in

Art Unit: 2655

view of Sit teaches multiple email accounts, and in combination with Cooper, teaches multiple email account access with for multiple user, who would have the option of checking email at their discretion, or in other, at different times)

As per claims 18-20, the combination of Klein (5479411) in view of Sit et al (6349336) in further view of Cooper et al (6052442) teaches contact information (Klein (5479411), col. 4 lines 2-19; and col. 5 lines 1-24)

As per claims 21,27,33,46, the combination of Klein (5479411) in view of Sit et al (6349336) in further view of Cooper et al (6052442) teaches email information can include other types of media (Klein (5479411), col. 6 lines 27-50).

### ***Response to Arguments***

3. Applicant's arguments filed 6/4/2004 have been fully considered but they are not persuasive. As per applicant's arguments that Klein does not teach automatic polling, examiner notes that the combination of Klein in view of Sit is used to address the automatic polling. As per applicant's arguments that Sit fails to teach the email server notifying a voicemail server and leaving a voicemail notification, examiner argues that this newly presented claim language is addressed by the new rejection presented above. Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

Art Unit: 2655

*Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

5. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872 ~~9314~~, **9306**

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Opsasnick, telephone number (703)305-4089, who is available Tuesday-Thursday, 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Doris To, can be reached at (703)305-4827. The facsimile phone number for this group is (703)872-~~9314~~. **9306**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (703) 305-4750, the 2600 Customer Service telephone number is (703) 306-0377.

mno  
7/30/2004

  
**W. F. YOUNG**  
**PRIMARY EXAMINER**